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EXAMINER	
NGUYEN, TAN D	
ART UNIT	PAPER NUMBER
3629	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/014,908	CIRCENIS, EDGAR	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 March 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/12/07 has been entered.

Response to Amendment

2. The amendment filed 3/12/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the underlined amended language "wherein each iCOD computer is an independent licensed system" and ", thereby allowing payment-free transfer of active assets from one iCOD computer to another iCOD computer within the network",

The examiner has scanned thoroughly through the specification and the figures but could not find the support for these specific language. Applicant is required to cancel the new matter in the reply to this Office Action.

Claims Status

As of 3/12/07, claims 1-30 are pending. There are 3 method claims: 10-15, 16-23, and 24-30 with 1 system claim 1-9 which is basically the system to carry out the first

method claim 10-15. Claim 10 appears to be the broadest method claim and will be addressed first.

Claim Rejections - 35 USC § 112

3. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As of 3/12/07, independent method claim 10 is as followed:

10. (currently amended) A method for measuring at least one monitored asset belonging to at least one asset class over a network with a plurality of instant capacity on demand (iCOD) computers comprising:

(a) receiving data about a quantity of assets of the at least one asset class for each iCOD computers on the network, wherein each iCOD computer is an independently licensed system;

(b) summing the quantity of assets of the at least one asset class for all of the plurality of iCOD computers on the network, thereby obtaining a sum of assets for the at least one asset class; and

(c) providing a notification if the sum of assets differs from a previously specified total for the assets for the at least one asset class, wherein the assets may be either active or inactive, thereby allowing payment-free transfer of active assets from one iCOD computer to another iCOD computer within the network.

Note: for convenience, alphabetical letters (a) – (c) are added to the beginning of each step.

1) In claim 10, it's not to whom the notification in step (c) is provided to?

2) What happens the scope of the invention if the information/data about the sum of assets, determined in step (b), is not different from a previously specified total for the assets for the at least one asset class?

3) Similarly, amended independent claims 16, 24, and 1 are rejected for the similar reasons set forth in the rejection of independent method claim 10 above since they have the same amended language.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 10-15, 16-23, 1-9, 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) AAPA (applicant admitted prior art) in view of (2) Article 1999 ("Hewlett-Packard ... at low risk").

In summary, **independent method[1] claim 10** deals with a method for measuring at least one monitored asset (computer component) belonging to at least one asset class over a network with a plurality of computers (cluster) comprising:

(a) receiving a data about quantity of assets (components) at the at least one asset class (CPU or storage) for each computer on the network, wherein each iCOD computer is an independently licensed system;

(b) summing (totalizing) the quantity of assets (components) of the at least one asset class for all of the plurality of iCOD computers on the network, thereby forming a sum of assets data, and

(c.) providing a notification (reminder) if the sum of assets data differs from a previously specified total data for the assets for the at least one asset class, wherein the assets may be either inactive or active, thereby allowing payment-free transfer of active assets from one iCOD computer to another iCOD computer within the network.

Note that the last step with the phrase "assets may be either inactive or active, thereby .... Within the network". The term "maybe" is considered as being optional since it reads over "is" or "is not", and therefore whatever limitations followed this "optional" limitation is considered as non-patentable weight since this is optional and not required. Moreover, what happens if the assets are "inactive"? Is there still a payment-

free transfer of active assets from one iCOD computer to another iCOD computer within the network?

Similarly, **AAPA**, as shown in the "Background" of pages 1-2, fairly discloses a method for measuring at least one monitored asset (computer component, i.e. CPU) belonging to at least one (or 1) asset class (CPU) over a network with a plurality of computers (cluster) comprising:

(a) receiving a data about an asset (computer components, i.e. CPU) at the at least one asset class (CPU or storage) for each computer on the network,

(b) summing the quantity of asset (computer components, CPUs) of the at least one asset class for each iCOD system (computer) individually on the network, thereby forming a sum of assets data, and

(c.) providing a notification (reminder) if the sum of assets data differs from a previously specified total data for the assets for the at least one asset class, wherein the assets may be either inactive or active.

{see page 1, 2nd paragraph}.

As for the new limitation in step (a), if it's found support in the specification, it appears that this limitation is inherently included or taught in AAPA as disclosed on pages 1-2 of the specification, especially paragraph no. 1 on page 1. Furthermore, it's not clear whether this new limitation makes any difference to step (a) since it's not clear how is it differs from the conventional iCOD computers of AAPA? As for the new limitation in step (c), if it's found support in the specification, as indicated above, it follows the previous limitation of "maybe" which is considered as being optional, thus

carrying no patentable weigtht. Moreover, what happens if the assets are "inactive"? Is there still a payment-free transfer of active assets from one iCOD computer to another iCOD computer within the network?

Therefore, it appears that AAPA teaches the claimed invention except for :

(1) a quantity of assets used in steps (a)-(c.) above, and

(2) step (b) is carried out on a single iCOD computer and not a plurality of iCOD computers on the network and potentially the new amended limitation on the last step if it's found support in the specification.

This is agreed upon by the applicant on the applicant's amendment of 9/26/06.

In a similar iCOD environment, **ARTICLE 11/1999** discloses future on-demand programs which will include other server (CPU) components, such as (1) memory and (2) input/output (I/O), (3) storage sub-systems and (4) HP's HyperPlex clusters to meet demands of customers whose livelihoods depend on delivering high levels of capacity, performance and availability for Internet-based applications and "pay as you go" infrastructure program which allows dynamic response to ever-changing business demands which is sensible and beneficial (economical) to the server and storage customers {see page 1, paragraphs 2, 4, 5 and 6, page 2, 1st and 2nd}. ARTICLE 1999 also teaches the concept of providing iCOD solution for HP 9000 Enterprise Servers and when customers' needs change and they need more processing power, they can instantly activate the needed processors with a simple HP-UX command and there will be no charge for activation {see page 1, paragraphs 4, 5 and page 2, paragraph 2}. It would have been obvious to modify the "on-demand" or "pay as you go"

program/method of AAPA by adjusting the summing or sum of assets to include other computer (CPU/server) components, such as (1) memory and (2) input/output (I/O), (3) storage sub-systems or (4) HP's HyperPlex **clusters**, in steps (a)-(c.) and on plurality of computers/servers (cluster or group) as taught by ARTICLE 11/1999 for one of the benefits cited above such as dynamic response, pay as you go, or sensible and beneficial (economical) to meet the consumer's demands for speed, content, availability, cost, etc. of internet-based applications which depend on those 4 variables cited above. Again, ARTICLE 1999 fairly teaches the users can instantly activate the needed processors with a command and no charge for activation, which indicate that the account/contract contains a plurality of iCOD computers (processors) or the provided clusters contain a plurality of iCOD computers (processors or servers). As for the amended limitation of the last step, this is inherently included or taught in view of the teachings of ARTICLE 11/1999 in view of AAPA in view of the teachings of "no charge for activation" as cited in above. Moreover, putting more than one computer on the service contract or account would have been obvious as mere duplicating service/parts for multiple effects on the same account if desired. See In re Harza, 124 USPQ 378, 380 (CCPA 1960).

As for dep. claim 11 (part of 10 above), which deals with well known audit reporting parameters/features, i.e. decrypting data due to sensitive data for personal or security reason, this is non-essential to the claimed invention and is well known and/or

inherently included in AAPA or ARTICLE 11/1999 or would have been obvious to do so for security/personal reason.

As for dep. claims 12-13 (part of 10 above), which deals with well known licensing auditing (iCOD / licensing) parameters, i.e. comparing actual/reported data to expected data for monitoring usage, these are well known and inherently included in AAPA {see page 1, 2nd full paragraph}.

As for dep. claims 14-15 (part of 10 above), which deals with well known licensing auditing (iCOD) parameters, i.e. issuing a payment or an invoice from the system vendor, these are well known parameters and are taught in AAPA page 1, 2nd paragraph.

As for independent system[1] claim 1, which is the system to carry out independent method claim 10 above, it's rejected over the system of AAPA /ARTICLE 11/1999 to carry out the method claim 1 as cited above. Moreover, it would have been obvious to a skilled artisan to set up the proper system to carry out the method steps as shown in claim 10 above.

As for dep. claims 2-5 (part of 1 above), which have the same limitations as in dep. claims 11-15 respectively, they are rejected for the same reasons set forth in dep. claims 11-15 above.

As for dep. claims 6-9 (part of 1 above), which deals with well known iCOD parameters, i.e. CPU, hard disk capacity, memory (storage), or I/O ports, etc., these are taught in ARTICLE 11/1999 page 1, 5th paragraph.

As for independent method[2] claim 16, which explicitly differs from independent method claim 10 at the 1st step "receiving data about", however, the result of the 1st and 2nd steps of claim 16, "measuring a quantity" and "transmitting the data about the quantity" producing the same result as in the 1st step of claim 10 above. Therefore, the 1st and 2nd steps of claim 10 are inherently included in the teachings of AAPA, page 1, 2nd paragraph.

As for dep. claims 17-18 (part of 16 above), which deals with well known licensing auditing (iCOD) parameters, i.e. measuring a quantity of inactive/active component, these are well known parameters and are taught in AAPA page 1, 2nd paragraph.

As for dep. claims 19-23 (part of 16 above), which have the same limitations as in dep. claims 11-15 respectively, they are rejected for the same reasons set forth in dep. claims 11-15 above.

As for independent method[3] claim 24, which differs from independent method claim 10 at the 1st step "grouping the computers into at least one cluster", however, this step is fairly taught in ARTICLE 11/1999 as one of the new iCOD option, HP's HyperPlex clusters, and is therefore inherently included in the teachings of AAPA / ARTICLE 11/1999.

As for dep. claim 25 (part of 10 above), which deals with well known audit reporting parameters of a clusters of network computers, i.e. registering the computers into the cluster, this is non-essential to the claimed invention and is inherently included

in AAPA or ARTICLE 11/1999 or would have been obvious to do so for keeping track of the computers in a cluster.

As for dep. claims 26-30 (part of 24 above), which have the same limitations as in dep. claims 11-15 respectively, they are rejected for the same reasons set forth in dep. claims 11-15 above.

Response to Arguments

7. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new examiner's arguments and rejections as cited above.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2003/0079092, section [0006] discloses the benefit of iCOD for storage disk which is high cost for capital, operating expenses for power, raised floor spaces, heat, no return on assets or investments (ROA or ROI) on unused storage disk.

No claims are allowed.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see http://pair-direct@uspto.gov. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are **(571) 273-8300**. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
May 21, 2007

DEAN T. NGUYEN
PRIMARY EXAMINER